

### REMARKS

The office action dated March 9, 2004 has been carefully reviewed. Claims 1-13 are pending in this application. Claims 11 and 12 have been withdrawn. Reconsideration of this application is respectfully requested.

#### 35 U.S.C. § 102 Rejection of Claims 1, 3-5, 8-10, and 13

Claims 1, 3-5, 8-10, and 13 were rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,645,594 issued to Devanathan et al. (hereinafter "Devanathan"). Applicants respectfully traverse this rejection. Reconsideration of claims 1, 3-5, 8-10, and 13 is respectfully requested.

#### Discussion Re: Patentability of Claim 1

Claim 1, as filed, is as follows:

1. A method of making an implantable bearing for an orthopaedic prosthesis, comprising the steps of:  
providing a first layer constructed of a polymer;  
providing a second layer constructed of a copolymer comprising ethylene and an acrylate;  
securing said first layer to said second layer so as to create a composite; and  
forming said composite into a predetermined shape of said implantable bearing.

The method of manufacturing a bearing disclosed in Devanathan does not include each of the above limitations recited in Applicants' claim 1. For example, amongst other things, the method of manufacturing a bearing disclosed in Devanathan does include the step of "providing a second layer constructed of a copolymer comprising ethylene and an acrylate". By contrast, the method disclosed in Devanathan includes securing a first layer of UHMWPE to a second layer of *blended* UHMWPE and poly methyl methacrylate (PMMA), with the PMMA portion of the blend being either PMMA homopolymers or PMMA copolymers. Clearly, Devanathan's blended second layer cannot be properly construed as "a second layer constructed of a copolymer comprising ethylene and an acrylate" as recited in Applicants' claim 1.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Devanathan does not disclose each and every element of Applicants' claim 1. As a result, Devanathan does not anticipate Applicants' claim 1.

If the rejection of claim 1 is maintained after considering the remarks presented herein, the Examiner is respectfully requested to specifically indicate where each limitation of claim 1 is disclosed in Devanathan (e.g. by line and column number).

#### Discussion Re: Patentability of Claim 3-5, 8-10, and 13

Each of claims 3-5, 8-10, and 13 includes claim 1 as a base claim. As a result, each of claims 3-5, 8-10, and 13 is allowable for the reasons hereinbefore discussed with regard to claim 1.

#### 35 U.S.C. § 103 Rejection of Claims 2, 6, and 7

Claims 2, 6, and 7 were rejected under 35 U.S.C. § 103 as being unpatentable over Devanathan. Each of claims 2, 6, and 7 includes claim 1 as a base claim. As a result, each of claims 2, 6, and 7 is allowable for the reasons hereinbefore discussed with regard to claim 1. Moreover, each of claims 2, 6, and 7 is allowable for additional reasons.

#### Conclusion

In view of the foregoing remarks, it is submitted that this application is in condition for allowance. Action to that end is hereby solicited.

In the event that there are any questions related to this response in particular, or to the application in general, the undersigned would appreciate the opportunity to address those questions directly in a telephone interview to expedite the prosecution of this application for all concerned.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and

shortages in other fees be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 with reference to file 265280-68188.

Respectfully submitted,

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